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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,413	10/25/2004	Seiji Kagawa	KAGAWA1	6666

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EXAMINER	
O HERN, BRENT T	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
03/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/512,413	KAGAWA ET AL.	
	Examiner	Art Unit	
	Brent T. O'Hern	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6,11-35,38-65,75 and 76* is/are pending in the application.

4a) Of the above claim(s) *11-35,38-62,64 and 65* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6,63,75 and 76* is/are rejected.

7)☒ Claim(s) *76* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Abandonment

1. On 9/14/2007 the Office mailed an Office action to Applicant which Applicant did not respond to within the statutory period.

On 5/16/2008 Applicant confirmed abandonment in a phone call with the Office. A Notice of Abandonment was mailed to Applicant on 6/2/2008

On 11/26/2008 Applicant filed a petition to revive the application as being unintentionally abandoned. The Office granted said petition and on 2/27/2009 forwarded the case to the Examiner along with arguments and amendments to the claims.

Claims

2. Claims 6, 11-35, 38-65 and 75-76 are pending with claims 11-35, 38-62, and 64-65 withdrawn and 75-76 new. Claims 6, 63 and 75-76 are not withdrawn.

WITHDRAWN REJECTIONS

3. All rejections of record in the Office Action mailed 14 September 2007, pages 3-6, paragraphs 5-8 have been withdrawn due to Applicant's amendments in the Paper filed 26 November 2008.

Claim 76 is objected to because of the following informalities: line 6 states "easily tom". This appears to be a typographical error. Appropriate correction is required.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

4. Claims 75-76, 6 and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The phrases "intervals" in claim 75, line 4 and claim 76, line 6 are vague and indefinite since it is unclear whether the measurement is from centerline to centerline of the scratches or from the edge of one scratch to the edge of another scratch or something else.

6. The phrases "scratches on its entire surface" in claim 75, line 2 and claim 76, line 3, are vague and indefinite since it is unclear whether 100% of the surface is covered with scratches without any space between the scratches or does "entire surface" mean that only part of the surface has scratches and another part does not have scratches. Furthermore, it is unclear whether the surface is only required to have a minimum of two scratches as long as they have the specified width, depth and interval. It is unclear whether part of the surface does not have scratches in the region along the borders of the sheet or is 100% of the sheet covered with scratches with 0% of the surface not having scratches, even at the borders. Additionally, since sheets are known to have both top and bottom surfaces, it is unclear whether scratches are on both surfaces of the sheet or just on one side/surface of the sheet.

Clarification and/or correction required.

Claim Rejections - 35 USC § 103

7. Claims 75-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 4,581,087) in view of Kai (US 4,543,279).

Johnson ('087) teaches a tearable sealant thermoplastic resin film *(See col. 3, ll. 19-45 and FIG-1, film #10.)*

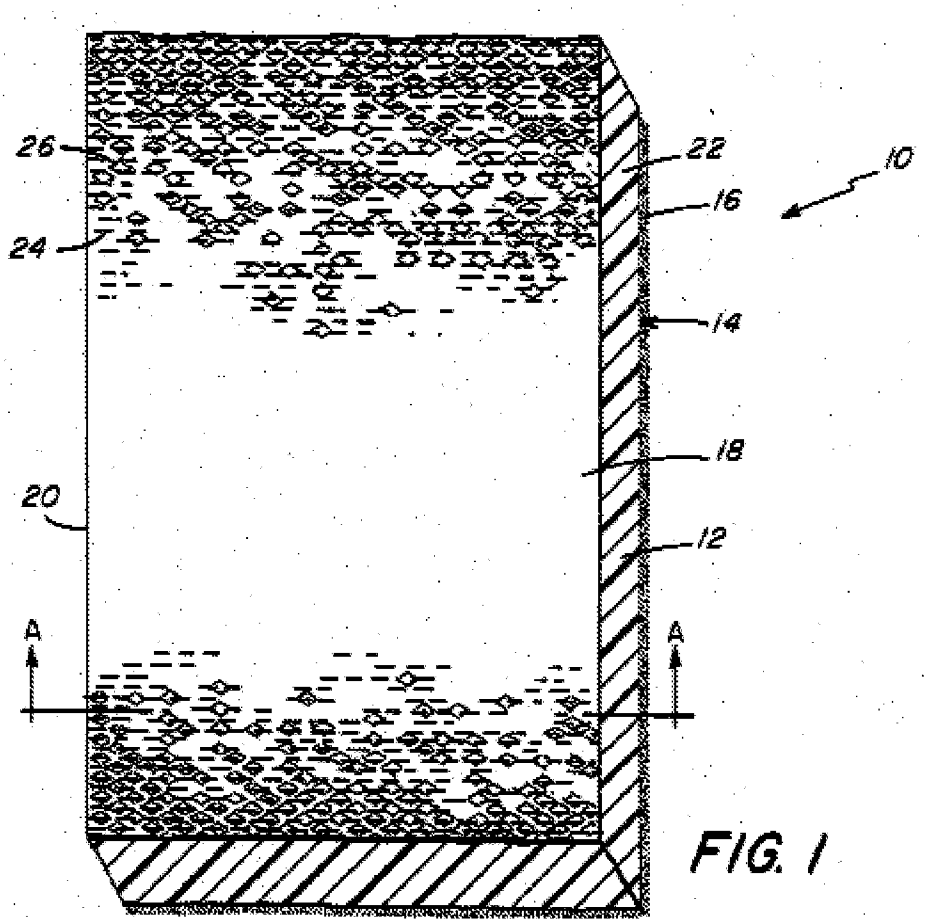

FIG. 1

having uniform, parallel, linear scratches on its entire surface produced by a rotating roll *(See FIGs 1 and 2 scratches #24 produced by a rotating roll #38 illustrated in FIG-4.)*

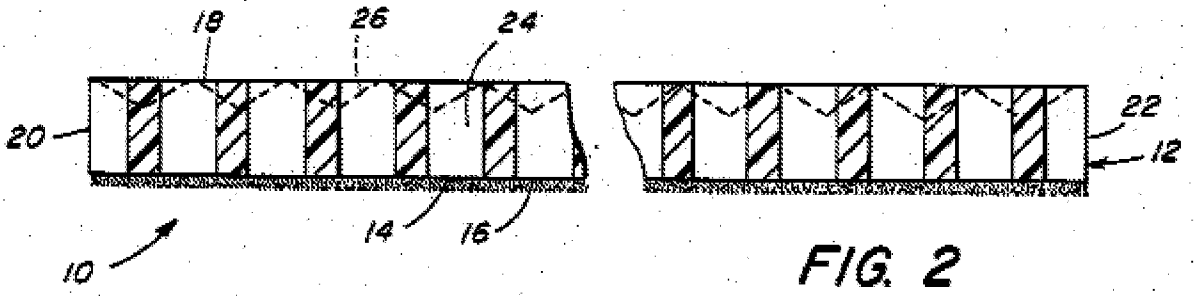

FIG. 2

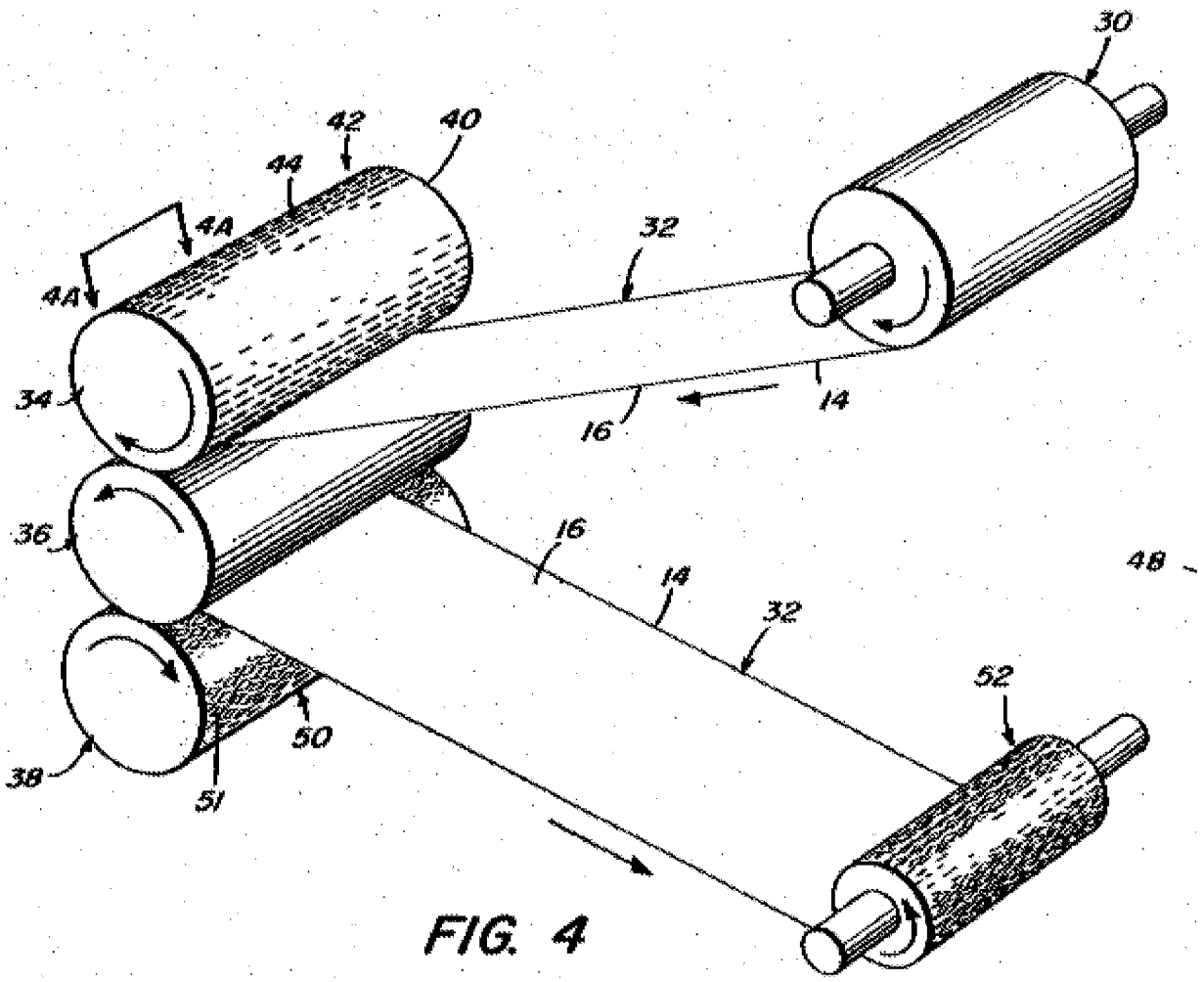

FIG. 4

with the linear scratches having a depth of 1 to 40% of the film thickness *(See col. 4, ll. 19-26, depth from 1 to 10%.)*, whereby said film is easily torn straight in one direction from any point along said linear scratches over its longitudinal length *(See FIG-1, and col. 4, ll. 26-35.)*, however, fails to expressly disclose said linear scratches having a width of 0.1 to 10 *μ*m and with intervals of 10 to 200 *μ*m, and the arrangement obtained by sliding contact with a rotating roll having fine hard particles with sharp edges over its entire surface.

Regarding the intervals, Johnson ('087) teaches the film being from 2 to 10 mils (50.8 to 254 μm) thick *(See col. 3 ll. 42-45.)* and the depth of the scratches being from 1 to 10% of the thickness of the film *(See col. 4, ll. 19-26.)* which equates to a depth of 0.5 to 25.4 μm for the purpose of providing a film that is readily hand-tearable *(See Abstract and col. 4, ll. 27-35.)*. When a ratio of scratch depth to interval separation of 3:1 is provided as is disclosed in FIG-2 then the intervals is from 1.5 to 76 μm which clearly falls within the above claimed range. Additionally, scratch depth to interval separation ratios significantly greater and smaller than this still provide for the above intervals. Ratios as low 0.4:1 and as high as 20:1 provide for the above claimed intervals for a film having the above thickness and scratches of the above depth. Therefore, it would have been obvious to provide a film with the above intervals in order to provide a film that is easy to tear.

Regarding the width of the scratches, Kai ('279) teaches wherein the depth of the scratches/holes is determined by the particle size of the grains on the abrasive *(See col. 3, l. 66 to col. 4, l. 7.),* are shallow enough to be invisible to the naked eye *(See col. 3, ll. 28-34.)* and wherein the width and depth of the scratches/holes arranged linearly vary depending on the kind and thickness of the sheet to be used *(See col. 3, ll. 63-58.)* for the purpose of providing a film that can easily be torn without changing the product *(See col. 3, ll. 43-52.)*.

Regarding the phrases "obtained by sliding contact with a rotating roll having fine hard particles with sharp edges over its entire surface" in claim 75, lines 2-3 and claim 76, lines 3-4, respectively, it is noted that said phrases are interpreted as being directed

towards the method and apparatus for producing the product and not towards further structural limitations beyond what is already set forth in the claims and taught by the prior art as discussed above. As discussed above, Johnson ('087) teaches the scratches in the surface produced by a rotating roll with surface configurations to produce scratches of the same depth *(See FIG-4, roller #38 for film #10 as disclosed in FIGs 1-2.)*.

As discussed above Kai ('279) teaches scratches produced in a tearable film by a rotating roll having an abrasive surface *(See col. 5, ll. 21-29 and FIG-4.)*.

Thus, it does not matter what is the precise configuration of the rolls when the structural limitations of the product taught by the prior art is the same as claimed and the product produced by the prior art is clearly capable of being produced by the same method and apparatus.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide Johnson's ('087) scratches with the above dimensions and configuration as discussed above and in view of Kai ('279) in order to provide a film that can easily be torn without changing the product.

8. Claims 6 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 4,581,087) in view of Kai (US 4,543,279) and Littmann et al. (US 5,512,337).

Regarding claim 6, Johnson ('087) and Kai ('279) teach the film with scratches as discussed above, however, fail to expressly disclose further having a multiplicity of uniformly located penetrating pores and an average opening diameter of 0.5 to 100 μm.

However, Littmann ('337) teaches a film further having a multiplicity of uniformly located penetrating pores *(See col. 5, l. 56 – col. 6, l. 7.)* for the purpose of providing a structure that is easy to tear *(See col. 6, ll. 1-7.)*.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to additionally provide or substitute Johnson's ('087) scratches by the pores of Littmann ('337) in order to provide a structure that is easy to tear.

Regarding claim 63, Johnson ('087), Kai ('279) and Littmann ('337) teach the film discussed above, however, fails to expressly disclose wherein the fine pores have an average opening diameter of 0.5 to 100 μm.

However, Kai ('279) teaches wherein the depth of the scratches/holes is determined by the particle size of the grains on the abrasive *(See col. 3, l. 66 to col. 4, l. 7.),* are shallow enough to be invisible to the naked eye *(See col. 3, ll. 28-34.)* and wherein the width and depth of the scratches/holes arranged linearly vary depending on the kind and thickness of the sheet to be used *(See col. 3, ll. 63-58.)* for the purpose of providing a film that can easily be torn without changing the product *(See col. 3, ll. 43-52.)*.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to modify Johnson's ('087) film with pores with the above dimensions in order to provide a film that can easily be torn without changing the product.

ANSWERS TO APPLICANT'S ARGUMENTS

9. In response to Applicant's argument *(See pp. 23-26 of Applicant's Paper filed 26 November 2008.)* regarding Kai ('279) as a primary reference, it is noted that Kai ('279) is no longer cited as a primary reference, thus, all arguments regarding such are moot.

10. In response to Applicant's arguments *(See pp. 21-22 of Applicant's Paper filed 26 November 2008.)* regarding Figures A-F being attached and arguments regarding such, it is noted that no figures are attached to said Paper.

11. In response to Applicant's arguments *(See pp. 24-25 of Applicant's Paper filed 26 November 2008.)* regarding newly presented independent claims 75 and 76, it is noted that the teachings of said claims are discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571)272-0496. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BTO/
Brent T. O'Hern
Examiner
Art Unit 1794
March 5, 2009

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794